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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,712	05/23/2001	Gregory Gardner	1986P	1736

7590 03/28/2005  
SAWYER LAW GROUP LLP  
P.O. Box 51418  
Palo Alto, CA 94303

EXAMINER
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GRAYSAY, TAMARA L

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 03/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/864,712

Applicant(s)

GARDNER, GREGORY

Examiner

Tamara L. Graysay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to
  - a. because the stray marking "Market Fusion" (Fig.3, 6-8) is not proper;
  - b. because reference character 312 is used to depict both the edit button and the view process button (Fig.3, and p.9-11);
  - c. because reference character 314 is used to depict both the create button and the upload button (Fig.3, and p.9-10);
  - d. as failing to comply with 37 CFR 1.84(h)(2) because partial views drawn on separate sheets (Fig.4 and 4(cont'd)) must always be capable of being linked edge to edge so that no partial view contains parts of another partial view, a smaller scale view should be included showing the whole formed by the partial views and indicating the position of the partial views, and each partial view must be labeled separately;
  - e. as failing to comply with 37 CFR 1.84(m) because the shading (Fig.3-8) does not aid in understanding the invention and reduces legibility;
  - f. as failing to comply with 37 CFR 1.84(o) because the legend which appears at the top of the figure (Figs.3, 5, 6, and 7) is not consistent with the description provided in the specification (MRP administration, MRP parts editor, MRP line editor [manual], MRP PO results [automatic], respectively);
  - g. as failing to comply with 37 CFR 1.84(p)(3) because the numbers (Fig.3-8) and letters (Fig.3-8) are not at least .32cm (1/8 inch) in height; and,

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- h. as failing to comply with 37 CFR 1.84(u)(1) because the partial views (Fig.4 and 4(cont'd), if intended to form one complete view, must be identified by the same number followed by a capital letter.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

2. The disclosure is objected to because of the following informalities:
- a. Reference character 312 is used to depict both the edit button and the view process button (p.9-10 and Fig.3).
  - b. Reference character 314 is used to depict the create button and the upload button (p.9-10 and Fig.3).
  - c. Reference character 304 is used to describe the upload button (p.10, 1.5) and the current MRP process (p.8 and Fig.3).

Appropriate correction is required.

*Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to nonstatutory subject matter.

*Claims 1-13*

A computer-related process claim is statutory if it falls within one or both of the specific safe harbor categories of post-computer activity or pre-computer activity. For purposes of this determination the process had been interpreted as merely and abstract idea of creating a document.

Post-Computer Activity: A claimed process is clearly statutory if it results in a physical transformation outside the computer, i.e., post-computer process steps that result in a physical transformation beyond merely conveying the direct result of the computer operation. In the present application, the claimed process creates the MRP document by processing data according to maps. There is no claimed activity or physical transformation beyond the bounds of a computer, even if computer implementation were claimed in the process.

Pre-Computer Activity: A claimed process is clearly statutory if it requires the measurement of physical objects or activities external to the computer and transformation of the signals corresponding to the measurement of the physical objects or activities, i.e., pre-computer process steps. In the present application, there is no process step that measures physical objects or activities.

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A computer-related process claim that does not fall within one or both of the specific safe harbor categories of post-computer activity or pre-computer activity may be statutory if it is limited to a practical application within the technological arts.

Practical Application: A practical application is one that produces a useful, concrete, and tangible result. In the present application, the process selects a processor definition comprising a map, creates more maps, provides source data, and creates a document or record by processing the data according to the maps. The claimed document or record is merely a compilation or arrangement of data that is contained within a computer or file, not a result that is concrete and tangible.

Technological Arts: For a process to be within the technological arts, it must do more than solve mathematical problems or manipulate abstract ideas or concepts that are nonstatutory. If the step(s) of the claimed process manipulate only numbers, abstract concepts or ideas, or signals representative thereof, then the process does not manipulate appropriate subject matter. In the present application, a human being can perform the process steps as claimed using paper and pencil, without applying, involving, using, or advancing technology.

Therefore, claims 1-13 are directed to nonstatutory subject matter.

#### *Claims 14-26*

The following analysis is made with regard to the “system” claims, in light of the indefiniteness of the claims as noted in the rejection below. The specification is silent as to the specific computer hardware, or hardware/software combination for implementing the invention. The

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claimed invention recites a “system” having two features: source data, and a processor definition comprising a map.

Nonfunctional Descriptive Material: The first feature is source data. Data that does not impart functionality to either the data as claimed or to the computer is nonfunctional descriptive material. Whether or not the material is recorded on a computer readable medium, a compilation of data is nonfunctional descriptive material and is nonstatutory subject matter. However, the analysis of the claim features continues to determine if there is statutory subject matter contained therein.

Computer Program: The second limitation is a processor definition comprising a map. One reasonable interpretation of the claimed feature is that it recites a computer program *per se*. A computer program *per se* does not define any structural and functional interrelationships that permit the computer program’s functionality to be realized. The claim is merely a compilation of data together with the processor definition, i.e., the “system” claim is devoid of any structural and functional interrelationships that permit the processor definition’s functionality to be realized.

Therefore, claims 14-26 are directed to nonstatutory subject matter.

#### *Claims 27-39*

The claims recite instructions for performing a process. Although the preamble recites a computer readable medium, there are no structural and functional interrelationships defined in the claims that permit the instructions to be realized. The claim is not formulated to include computer executable program stored on the computer readable medium for execution by a

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computer. As such, the claims are nothing more than a computer readable medium “with” program instructions. Therefore, claims 27-39 are directed to nonstatutory subject matter.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 14-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Regarding claims 14-26, the preamble recites “A system,” and the body of the claim recites data and a processor definition. The body of the claim does not include any structure, but rather is a compilation of data (nonfunctional descriptive material) and a set of instructions (arguably, a computer program). The lack of structure in the body of the claim and the preamble recitation “system” renders the claim indefinite in that it is not clear whether the claim is drawn to a product, a process performed by a product, or something else. The claim must be clarified as to the metes and bounds of protection desired: whether the claim is a product or process. For purposes of this Office action, the claim has been treated as a product or apparatus claim.

b. Regarding claims 27-39, the examiner notes three reasons in support of the indefiniteness. First, the preamble recites “A computer readable medium;” however, the body of the claim includes neither structure of the computer readable medium nor a structural and functional interrelationship of the processor definition to a computer



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readable medium. Second, the recitation of “with” at line 1 is not sufficient to impart any structural and functional interrelationship. Third, even if the program instructions at line 1 were construed as a structural and functional interrelationship with the computer readable medium, the recitation of “the instructions” at line 2 is confusing, in that the feature may or may not be part of the program instructions, e.g., the instructions further comprising.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Eder (US-5615109). This reference is taken as a whole as to the disclosure thereof. The following is a general discussion of the reference disclosure and, when necessary, particular reference is made to the reference by column and line number.

Regarding claims 1-13, Eder discloses a method for manufacturing purchase orders comprising the steps of selecting a processor definition (application software 55 c.21, 1.58 to c.22, 1.15), creating maps from a transfer map (data mapping information c.21, 1.64), providing source data (after mapping information is entered, data source connection is established c.21, 1.67), and creating a database record (c.22, 1.1-15).

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Further regarding claims 5 and 6, Eder discloses purchase orders and requests for quotation (open (purchasing and /or manufacturing) order balances, account balances, price schedules, etc. c.38, l.18-35). Eder discloses MRP items (item-vendor relationships c.38, l.23), defaults and settings (user is prompted by the software when entering data), processor (Eder processes the data that is entered), creating a plurality of maps before processing data (software system checks to make sure mapping tables are completed and stored before data source connection is established c.21, l.58-67), required map (required data c.22, l.1-11 and c.37), primary map (non-required data c.22, l.1-11 and c.37), active map (user inputs data c.22 l.1-11), default map (c.22 and c.37), and column map (database 90 having tables and fields c.38).

Regarding claim 13, Eder inherently has an MRP item map since MRP items are disclosed (c.38, l.18-35).

Regarding claims 14-26, Eder includes a system having a data source (database or user-input) and processor definition (application software).

Regarding claims 27-39, Eder inherently includes a computer-readable medium 52, 72 containing the application software program .

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Tyler (US-5523942) teaches a design lattice 48 for mapping data.
- Holloway (US-5253164) teaches a program instruction that is used for mapping data

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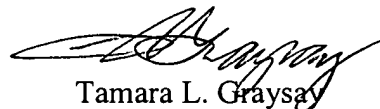
- Miller (US-5235702) teaches automated mapping for source data.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is (703) 305-1918.

The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamara L. Graysay  
Examiner  
Art Unit 3623

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